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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/765,837	10/06/97	LAUB	R VANMA48.001A

HM11/0817
KNOBBE MARTENS OLSON & BEAR
620 NEWPORT CENTER DRIVE
SIXTEENTH FLOOR
NEWPORT BEACH CA 92660

EXAMINER	
LUBET, M	
ART UNIT	PAPER NUMBER
1644	

DATE MAILED: 08/17/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/765,837

Applicant(s)

Laub et al.

Examiner

Lubet

Group Art Unit

1644

☒ Responsive to communication(s) filed on Oct 6, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 31-43 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 31-43 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Donald E. Adams, Ph.D., Supervisory Patent Examiner at Donald.Adams@uspto.gov or 703-308-0570. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group 1, claims 31-36, 38, 39, 41 and 42, drawn to an antigenic polypeptide fragment of Factor VIII having a particular amino acid sequence and a method of using polypeptide to treat an immune disorder. Claim 38 is included in this group to the extent it reads upon an anti-inhibitor which is a polypeptide of Group I.

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Group II, claims 37, 39, and 41, drawn to an inhibitor of Factor VIII which exhibits immunoaffinity for a polypeptide of Group I and a method of using the inhibitor to treat an immune disorder.

Group III, claims 38, 39 and 41, drawn to an anti-inhibitor which is directed to an inhibitor of Factor VIII (IE an anti-idiotypic antibody specific for the inhibitor of Group II)and a method of using the anti-inhibitor to treat an immune disorder .

Group IV, claim 43, drawn to a process of identifying an anti-inhibitor of Factor VIII .

Group V, claim 40 , drawn to a device comprising an polypeptide of Group I.

Group VI, claim 40 , drawn to a device comprising an polypeptide of Group II.

Group VII, claim 40 , drawn to a device comprising an anti-inhibitor of Group III.

2. The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The special technical feature of Group I is considered to be polypeptide fragment of Factor VIII and the first method of using the polypeptide of Group to obtain an inhibitor of Factor VIII .

The technical feature of Group II is considered to be the inhibitor of Factor VIII, said inhibitor having immunoaffinity for a polypeptide of Group I, IE an antibody specific for Factor VIII.

The technical feature of Group III is considered to be an anti-inhibitor of Factor VIII which is not polypeptide of Group I, IE anti-idiotypic antibody to the inhibitor of Group II (disclosed on page 22 of the specification).

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The technical feature of Group IV is considered to be the process of identifying an anti-inhibitor of Factor VIII, which is a method of using inhibitor of Group II.

The technical feature of Group V is a device, comprising a polypeptide of Group I.

The technical feature of Group VI is considered to be a device comprising the invention of Group II.

The technical feature of Group VII is considered to be a device comprising the invention of Group III.

3. Election of Species:

4. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Group I: the plurality of species of peptides (fragments of Factor VIII) recited in claims 31, 32, 34, and 35.

Group V: a device comprising the plurality of species of peptides recited in claims 31, 32, 34, and 35.

Applicant is required, in reply to this action, to elect a single embodiment to which the claims shall be restricted if no generic claim is finally held to be allowable.

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If Applicant elects Group I, Applicant is required to elect a particular species of polypeptide, IE a polypeptide containing SEQ. ID. NO. 1 and SEQ. ID. NO. 2. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

If Applicant elects Group V, Applicant is required to elect a particular species of polypeptide, IE a device comprising a polypeptide containing SEQ. ID. NO. 1 and SEQ. ID. NO. 2.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. The claims are deemed to correspond to the species listed above in the following manner:

The following claim(s) are generic: Group I: 31-36, 38, 39 and 42

Group V: Claim 40.

6. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: Each species of polypeptide has unique biochemical, functional and immunological properties.

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7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martha Lubet in Art Unit 1644 whose telephone number is (703) 305-7148. The examiner can normally be reached on Monday through Friday from 8:15 AM to 4:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan, can be reached at (703) 305-3973. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Martha T. Lubet

August 16, 1998


THOMAS M. CUNNINGHAM
PRIMARY EXAMINER
GROUP 1800



RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

FROM/ATTORNEY:

FIRM:

PAGES, INCLUDING COVERSHEET:

PHONE NUMBER:

TO EXAMINER: M. Lubet

ART UNIT: 1644

SERIAL NUMBER:

FAX/TELECOPIER NUMBER: (703) 305-3704

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COMMENTS: _____

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